

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Benny et al.	:	Osman, Ramy M.
	:	
Serial No.: 09/876,090	:	Group Art Unit: 2157
	:	
Filing Date: June 7, 2001	:	
	:	
Title: ENTERPRISE SERVICE	:	IBM Corporation
DELIVERY TECHNICAL	:	Intellectual Property Law
FRAMEWORK	:	11400 Burnet Road
	:	Austin, Texas 78758
	:	

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated February 20, 2008, with a two-month statutory period for response set to expire on April 20, 2008.

I. RESPONSE TO EXAMINER'S ARGUMENTS:

- A. Response to Examiner's assertion that claims 23-24 are properly rejected under 35 U.S.C. §101, as discussed on pages 10-11 of Examiner's Answer.

The Examiner asserts that claim 23 is directed to non-statutory subject matter under 35 U.S.C. §101 based on the fact that the preamble is direction to a technical framework. Examiner's Answer, page 10. However, as Appellants pointed out in Appellants' Appeal Brief (pages 9-10), the claims must be construed in light of the Specification when determining whether the claimed subject matter is statutory. See, *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1371, 47 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1998). As discussed in Appellants' Appeal Brief (pages 7 and 10), creating a technical framework for use in delivering a specific set of information technology services for a customer, as recited in claims 23-24, is used to provide a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next (see page 3, line 11 – page 4, line 3 of Appellants' Specification). Providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next is not an abstract idea (e.g., theory of relativity) as asserted by the Examiner. Instead, a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next is a useful, concrete and tangible result.

Further, the Examiner makes the statement that some of the steps in claim 23 can be performed by a person. Examiner's Answer, page 10. As a result, the Examiner, citing M.P.E.P. §2106(IV)(C)(2), asserts that claim 23 is directed to non-statutory subject matter. Examiner's Answer, page 10. Appellants respectfully traverse.

M.P.E.P. §2106(IV)(C)(2) states that claims directed to an abstract idea, law of nature or natural phenomenon are directed to non-statutory subject matter. Appellants have repeatedly made the same assertion. However, claim 23 is clearly

not directed to an abstract idea, a law of nature or a natural phenomenon (e.g., $E=mc^2$, a mathematical algorithm). It does have a substantial practical application, namely, providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next. Hence, M.P.E.P. §2106(IV)(C)(2) does not support the Examiner's conclusion that claim 23 is directed to non-statutory subject matter.

Further, M.P.E.P. §2106(IV)(C)(2) is silent regarding the conclusion that if any step of a claim can be performed by a person, then the claim must be directed to non-statutory subject matter. The Examiner has not cited to any case law to support this position. Appellants respectfully assert that such a position is not supported by case law. Further, the Examiner has not provided any evidence that any of the limitations in claim 23 can be performed by a person. For example, the Examiner has not cited to any passage in Appellants' Specification which discusses these limitations in connection with the assertion that these limitations can be performed by a person. Hence, M.P.E.P. §2106(IV)(C)(2) does not support the Examiner's conclusion that claim 23 is directed to non-statutory subject matter.

Further, the Examiner asserts that a "framework" identifies how parts fit together. Examiner's Answer, page 10. Appellants respectfully assert that Appellants' Specification states that a framework is a fundamental and basic arrangement of subcomponents or parts. Page 11, lines 18-19 of Appellants' Specification. Appellants' Specification further states that a framework typically identifies how those parts fit together at the highest level. Page 11, lines 19-20 of Appellants' Specification. A framework is not an abstract idea as asserted by the Examiner.

In connection with claim 24, the Examiner focuses on the term "for" in the preamble of claim 24 as allegedly causing claim 24 to be directed to non-statutory subject matter. Examiner's Answer, page 10. Appellants respectfully traverse. The preamble states "a computer program product for storage on a computer readable medium." There is nothing that suggests the assertion that the computer program

product is not physically embodied on a computer readable medium. How does the term "for" cause one of ordinary skill in the art to construe that the computer program product may be embodied in something other than a computer, as asserted by the Examiner on page 11 of the Examiner's Answer? As the preamble specifically states, the computer program product is for storage on a computer readable medium. There is no ambiguity.

Further, the Examiner cites M.P.E.P. §2106.01(I) in support of the assertion that claim 24 is directed to non-statutory subject matter. Examiner's Answer, page 11. Appellants are not claiming a data structure or a computer listing. Appellants are claiming a computer program product for storage on a computer readable medium and operable for creating a technical framework for use and delivering a specific set of information technology services for a customer. Thus, M.P.E.P. §2106.01(I) does not support the Examiner's stance that claim 24 is directed to non-statutory subject matter.

Further, the Examiner asserts that claim 24 is directed to a signal. Examiner's Answer, page 11. Appellants respectfully traverse. Claim 24 is clearly not directed to a signal. Instead, claim 24 is directed to a computer program product embodied on a computer readable medium, which is a physical device. Appellants are not claiming a signal. Hence, claim 24 is directed to statutory subject matter.

B. Response to Examiner's provisional obviousness-type double patenting rejection of claims 22-25, as discussed on pages 11-12 of Examiner's Answer.

Appellants note that if the "provisional" double patenting rejection is the only rejection remaining in an application (either the present application or in Application No. 09/875,863 or in Application No. 09/875,865), then the Examiner should withdraw the rejection and permit that application to issue as a patent. M.P.E.P. §804. The "provisional" double patenting rejection may then be converted into a double patenting rejection in the other application at the time the one application issues as a patent. M.P.E.P. §804.

- C. Response to Examiner's assertion that Hill discloses "determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services" as recited in claim 22 and similarly in claims 23-25, as discussed on pages 12-13 of Examiner's Answer.

The Examiner had previously cited column 1, line 53 – column 2, line 10; and column 3, lines 10-65 of Hill as disclosing "determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services" as recited in claim 22 and similarly in claims 23-25. Office Action (1/11/2007), page 7. The Examiner now cites column 2, lines 62-64 of Hill as disclosing a solution scope. Examiner's Answer, page 12. The Examiner now further cites column 1, lines 35-51 as disclosing the solution scope guided by an information technology services contract with the customer. *Id.* at pages 12-13. Further, the Examiner asserts that Hill inherently discloses the claimed services contract. *Id.* at page 13. Additionally, the Examiner cites column 6, line 64 – column 7, line 8 of Hill as disclosing the solution scope based on common practices for delivering certain types of information technology services. *Id.* Appellants respectfully traverse.

Hill instead discloses that processing device 22 generates a hierarchical list 62 and a hierarchical graph 54, each of which represents the information technology infrastructure of the organization, and can be a personal computer (PC), a workstation, a mainframe, an integrated circuit (IC), or any other device that can electronically process data. Column 2, lines 61-67.

Hence, Hill discloses generating a hierarchical list representing the information technology infrastructure of the organization.

There is no language in the cited passage that discloses that the hierarchical list corresponds to the solution scope, as described at least in part in one embodiment in connection with element 317 of Applicants' Specification. Neither is there any

language in Hill that discloses that the hierarchical list is guided by an information technology services contract with the customer. Neither is there any language in Hill that discloses that the hierarchical list is based on common practices for delivering certain types of information technology services.

Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Furthermore, Hill instead discloses that the present invention provides representations of the information technology infrastructure of an organization in interactive and graphical formats that are readily discernible and technically useful. Column 1, lines 35-38.

Hence, Hill discloses providing representations of the information technology infrastructure of an organization in interactive and graphical formats that are readily discernible and technically useful.

There is no language in the cited passage that discloses a solution scope guided by an information technology services contract with the customer. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Further, the Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Hill inherently discloses a services contract with the customer. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Hill inherently discloses a services contract with the customer, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 22-25. M.P.E.P. §2112.

Further, Hill instead discloses that each level in hierarchical list 62 corresponds to one of the element types of the organization--organization,

organization function, application, subsystem, or database, and, hence, is a level used to represent the information technology infrastructure. Column 6, line 65 – column 7, line 2. Hill further discloses that to assist in presenting this representation of the information technology information infrastructure, hierarchical list 62 can expand and contract at each information technology element and each organizational element. Column 7, lines 3-6. Furthermore, Hill discloses that if hierarchical list 62 is too large to fit within section 61, a toolbar 63 will allow scrolling through hierarchical list 62. Column 7, lines 6-8.

Hence, Hill discloses a hierarchical list, in which each level corresponds to one of the element types of the organization—organization, organization function, application, subsystem, or database, and, hence, is a level used to represent the information technology infrastructure.

There is no language in the cited passage that discloses a solution scope based on common practices for delivering certain types of information technology services. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Lastly, in connection with the rejection of the above-cited claim limitations, the Examiner asserts that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b). Examiner's Answer, page 12. Appellants respectfully disagree. Appellants pointed out which elements were not taught in Hill as asserted by the Examiner. By the Examiner asserting that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b), the Examiner attempts to reverse the burden. The Examiner though bears the initial burden of establishing a *prima facie* case of anticipation. *See In re King*, 801 F.2d 1324, 1327, 231 U.S.P.Q. 136, 138-39 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970). It is the Examiner's burden, and not Appellants, to specifically show where in Hill these elements are disclosed. Appellants have shown that Hill does not disclose each of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

- D. Response to Examiner's assertion that Hill discloses "mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities" as recited in claim 22 and similarly in claims 23-25, as discussed on pages 13-14 of Examiner's Answer.

The Examiner cites column 9, lines 6-8, 12-15 of Hill as disclosing "mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model" as recited in claim 22 and similarly in claims 23-25. Examiner's Answer, page 14. The Examiner further cites column 4, lines 40-46 and column 6, line 64 – column 7, line 2 of Hill as disclosing "the technical model describing people, processes, tools and information used to deliver specific services to customers" as recited in claim 22 and similarly in claims 23-25. *Id.* Additionally, the Examiner cites column 4, lines 40-55 and column 6, line 64 – column 7, line 2 of Hill as disclosing "the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities" as recited in claim 22 and similarly in claims 23-25. *Id.* Appellants respectfully traverse.

Hill instead discloses that as illustrated, hierarchical graph 54 uses a five-level hierarchical order to represent the information technology infrastructure of the organization, corresponding to the five levels specified in data file 48 in Figure 2. Column 9, lines 5-9. Hill further discloses that a third level 130, a fourth level 140, and a fifth level 150 correspond to the information technology elements of the organization--application, subsystem, and database, respectively. Column 9, lines 12-15.

Hence, Hill discloses a graph that uses a five-level hierarchical order to represent the information technology infrastructure of the organization, where the 3rd, 4th and 5th level correspond to the application, subsystem and database, respectively.

There is no language in the cited passage that discloses mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Further, Hill instead discloses that data file 42 uses five levels to represent the information technology infrastructure of the organization—organization, organization function, application, subsystem, and database. Column 4, lines 40-43. Additionally, Hill discloses that each level in hierarchical list 62 corresponds to one of the element types of the organization--organization, organization function, application, subsystem, or database, and, hence, is a level used to represent the information technology infrastructure. Column 6, line 65 – column 7, line 2. Hill further discloses that to assist in presenting this representation of the information technology information infrastructure, hierarchical list 62 can expand and contract at each information technology element and each organizational element. Column 7, lines 3-6. Furthermore, Hill discloses that if hierarchical list 62 is too large to fit within section 61, a toolbar 63 will allow scrolling through hierarchical list 62. Column 7, lines 6-8.

Hence, Hill discloses a hierarchical list, in which each level corresponds to one of the element types of the organization--organization, organization function, application, subsystem, or database, and, hence, is a level used to represent the information technology infrastructure.

There is no language in the cited passages that discloses a technical model describing people, processes, tools and information used to deliver specific services to customers. Instead, Hill discloses a hierarchical list, where each level corresponds to an element type of the organization. The hierarchical list does not describe people, processes, tools and information used to deliver specific services to customers. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Neither is there any language in the cited passages that discloses architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Additionally, in connection with the rejection of the above-cited claim limitations, the Examiner asserts that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b). Examiner's Answer, page 13. Appellants respectfully disagree. Appellants pointed out which elements were not taught in Hill as asserted by the Examiner. By the Examiner asserting that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b), the Examiner attempts to reverse the burden. The Examiner though bears the initial burden of establishing a *prima facie* case of anticipation. *See In re King*, 801 F.2d 1324, 1327, 231 U.S.P.Q. 136, 138-39 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970). It is the Examiner's burden, and not Appellants, to specifically show where in Hill these elements are disclosed. Appellants have shown that Hill does not disclose each of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

- E. Response to Examiner's assertion that Hill discloses "creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components" as recited in claim 22 and similarly in claims 23-25, as discussed on pages 14-15 of Examiner's Answer.

The Examiner cites column 4, lines 40-46 and column 6, line 64 – column 7, line 2 of Hill as disclosing "creating a list of design objects as a function of the solution scope for the technical framework" as recited in claim 22 and similarly in claims 23-25. Examiner's Answer, page 15. The Examiner further cites column 4, lines 40-46 and column 9, lines 5-14 of Hill as disclosing "the design objects based on logical groupings of architectural building blocks, including software and

hardware components" as recited in claim 22 and similarly in claims 23-25. Appellants respectfully traverse.

As stated above, Hill instead discloses that data file 42 uses five levels to represent the information technology infrastructure of the organization—organization, organization function, application, subsystem, and database. Column 4, lines 40-43. Additionally, Hill discloses that each level in hierarchical list 62 corresponds to one of the element types of the organization--organization, organization function, application, subsystem, or database, and, hence, is a level used to represent the information technology infrastructure. Column 6, line 65 – column 7, line 2. Hill further discloses that to assist in presenting this representation of the information technology information infrastructure, hierarchical list 62 can expand and contract at each information technology element and each organizational element. Column 7, lines 3-6. Furthermore, Hill discloses that if hierarchical list 62 is too large to fit within section 61, a toolbar 63 will allow scrolling through hierarchical list 62. Column 7, lines 6-8.

Hence, Hill discloses a hierarchical list, in which each level corresponds to one of the element types of the organization--organization, organization function, application, subsystem, or database, and, hence, is a level used to represent the information technology infrastructure.

There is no language in the cited passages that discloses creating a list of design objects. Neither is there any language in the cited passages that discloses creating a list of design objects as a function of the solution scope for the technical framework. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Furthermore, Hill instead discloses that data file 42 uses five levels to represent the information technology infrastructure of the organization—organization, organization function, application, subsystem, and database. Column 4, lines 40-43. Hill further discloses that as illustrated, hierarchical graph 54 uses a five-level hierarchical order to represent the information technology infrastructure of the

organization, corresponding to the five levels specified in data file 48 in Figure 2. Column 9, lines 5-9. Hill further discloses that a third level 130, a fourth level 140, and a fifth level 150 correspond to the information technology elements of the organization--application, subsystem, and database, respectively. Column 9, lines 12-15.

Hence, Hill discloses a data file that uses five levels to represent the information technology infrastructure of the organization. Hill further discloses a graph that uses a five-level hierarchical order to represent the information technology infrastructure of the organization.

There is no language in the cited passages that discloses design objects based on logical groupings of architectural building blocks, including software and hardware components. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Additionally, in connection with the rejection of the above-cited claim limitations, the Examiner asserts that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b). Examiner's Answer, page 15. Appellants respectfully disagree. Appellants pointed out which elements were not taught in Hill as asserted by the Examiner. By the Examiner asserting that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b), the Examiner attempts to reverse the burden. The Examiner though bears the initial burden of establishing a *prima facie* case of anticipation. *See In re King*, 801 F.2d 1324, 1327, 231 U.S.P.Q. 136, 138-39 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970). It is the Examiner's burden, and not Appellants, to specifically show where in Hill these elements are disclosed. Appellants have shown that Hill does not disclose each of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

- F. Response to Examiner's assertion that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b) in connection with Appellants' arguments traversing the Examiner's assertion that Hill discloses "designating relationships between the design objects as a function of

the solution scope and the specific set of information technology services for the customer" as recited in claim 22 and similarly in claims 23-25, as discussed on pages 15-16 of Examiner's Answer.

The Examiner asserts that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b) in connection with Appellants' arguments traversing the Examiner's assertion that Hill discloses "designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer" as recited in claim 22 and similarly in claims 23-25. Examiner's Answer, page 15. Appellants respectfully disagree. Appellants pointed out which elements were not taught in Hill as asserted by the Examiner. By the Examiner asserting that Appellants' arguments fail to comply with 37 C.F.R. §1.111(b), the Examiner attempts to reverse the burden. The Examiner though bears the initial burden of establishing a *prima facie* case of anticipation. See *In re King*, 801 F.2d 1324, 1327, 231 U.S.P.Q. 136, 138-39 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970). It is the Examiner's burden, and not Appellants, to specifically show where in Hill these elements are disclosed. Appellants have shown that Hill does not disclose each of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

G. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Appeal Brief (8/28/2007) and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION:

For the reasons stated above and in Appellants' Appeal Brief (8/28/2007), Appellants respectfully assert that the rejections of claims 22-25 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 22-25.

Respectfully submitted,

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